

**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record**

## **BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/829,623      | 04/10/2001  | Akira Koseki         | JP920000050         | 7981             |

7590 10/13/2004  
Robert P. Tassinari, Jr.  
Intellectual Property Law Dept.  
IBM Corporation  
P.O. Box 218  
Yorktown Heights, NY 10598

EXAMINER

PHAM, THOMAS K

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2121

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

**Application No.**

09/829,623

**Applicant(s)**

KOSEKI, AKIRA

**Examiner**

Thomas K Pham

**Art Unit**

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152).
- 6) ☐ Other: \_\_\_\_\_.

**First Action on the Merits**

1. Claims 1-16 of U.S. Application 09/829,623 filed on 4/10/2001 are presented for examination.

**Quotations of U.S. Code Title 35**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2121

### **Claim Rejections - 35 USC § 102**

6. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,933,811 (“Angles”).

#### **Regarding claim 1**

Angles teaches an information providing method for a network, for providing, via a network, content that constitutes an entire body of information based on conditions that are defined in advance, comprising the steps of:

*generating a finite number of intermediate contents for content that corresponds to an entire body of information* (see col. 18 lines 63-66, “The advertisement provider computer 18 processes the consumer preferences and **select an appropriate** advertisement from the **advertisement database**”. Here, the advertisement provider is supplying a customized or finite number of advertisement information from the entire advertisement database.);

*selecting at least one of said intermediate contents and providing information at a selected level* (see col. 8 lines 58-61, “The advertisement provider computer 18 **selects** an appropriate advertisement based on the consumer’s profile and then **sends** the customized advertisement 30 to the consumer computer 12”).

#### **Regarding claim 2**

Angles further teaches *wherein information contained in said content is employed as said intermediate content* (see col. 5 lines 30-32, “the customized advertisements are generated by an advertisement provider computer whenever a consumer accesses a content provider website”. The advertisement provider is providing information intermediately based on the interaction between the consumer and the content provider website.).

Art Unit: 2121

**Regarding claim 3**

Angles further teaches *wherein information obtained by changing at least a part of said information included in said content is employed as said intermediate content* (see example of col. 15 lines 35-39, “one version of an advertisement can be directed to selling fruit juice to children. Other versions of the advertisement, can be directed to selling the same fruit juice to teenagers, adults, or different demographic groups”. Here, the information has been changed appropriately.).

**Regarding claim 4**

Angles further teaches *wherein a condition determined in accordance with a request from a user is defined as said condition that is defined in advance* (see col. 14 lines 19-22, “The demographic data can contain a wide variety of information, including, but not limited to, age, sex, income, career, interests, hobbies, consumer preferences”. The advertisement provider uses the demographic data as a condition for providing customized advertise information that defined in advance by the consumer.).

**Regarding claim 5**

Angles further teaches *wherein an intermediate content is selected at a level that corresponds to said condition determined in accordance with said request from said user* (see col. 8 lines 47-49, “the consumer computer executes the advertisement request 26 and established communications link with the advertisement provider computer 18”, and col. 8 lines 58-61, “The advertisement provider computer 18 selects an appropriate advertisement based on the consumer’s profile and then sends the customized advertisement 30 to the consumer computer 12”).

**Regarding claim 6**

Art Unit: 2121

Angles further teaches *wherein a condition for reducing or increasing the amount of information in said content is defined as said condition that is defined in advance* (see col. 14 lines 19-24,

“The demographic data can contain a wide variety of information, including, but not limited to, age, sex, income, career, interests, hobbies, consumer preferences, the account number of the consumer’s Internet provider, other account information, etc.” Similar to the rejection of claim 4 above, the condition is defined in advance by the user. Furthermore, a condition for reducing or increasing the amount of information to be provide to the consumer are inherently according to the level of detail given by the consumer during registration.).

#### **Regarding claim 7**

Angles further teaches *wherein a condition for extracting an information type that represents said content is employed as said condition determined in advance* (similar to the rejection of claim 6 above, the type of information is provided changes based on the information provided by the consumer during registration.).

#### **Regarding claim 8**

Angles further teaches *wherein price information is provided for said contents, and compensation information based on said price information is provided for each of said intermediate contents at said levels that are generated* (see col. 16 lines 31-34, “the invention can pay an Internet provider 34 based on the number of advertisements viewed by its consumers. The Internet providers 34 can then use this advertising revenue to **reduce consumer access fees**”. The consumer is compensated for looking at the advertisement based on how much Internet provider gets paid from the advertisers.).

Art Unit: 2121

### Regarding claim 9

Angles teaches an information providing apparatus comprising:

*storage means for storing content that constitutes an entire body of information* (see fig. 4; also see col. 15 lines 33-35, “the advertisement database 700 contains numerous advertisements which have been designed for different types of consumers”);

*connection means for connecting said content to a network so as to provide said content* (see fig. 4; also see col. 16 lines 53-55, “The data flow sequence for the customized advertisement processing is illustrated with events C through F”. Data flow F of fig. 4 provides content to the consumer via a network medium.);

*generation means for, based on a condition determined in advance, generating intermediate contents at a finite number of levels relative to said content* (see col. 18 lines 63-66, “The advertisement provider computer 18 processes the consumer preferences and **select an appropriate** advertisement from the **advertisement database**”. Here, the advertisement provider is supplying a customized or finite number of advertisement information from the entire advertisement database.); and

*output means for selecting and outputting at least one of said intermediate contents* (see col. 8 lines 58-61, “The advertisement provider computer 18 selects an appropriate advertisement based on the consumer’s profile and then **sends** the customized advertisement 30 to the consumer computer 12”).

### Regarding claim 10

Angles further teaches *wherein said generation means employs information included in said content to generate intermediate contents at a finite number of levels* (see col. 18 lines 63-66,



Art Unit: 2121

“The advertisement provider computer 18 processes the consumer preferences and **select an appropriate** advertisement from the **advertisement database**”. Here, the advertisement provider is supplying a customized or finite number of advertisement information from the entire advertisement database.).

#### **Regarding claim 11**

Angles further teaches *wherein said generation means employs information obtained by changing at least a part of the information included in said content to generate intermediate contents at a finite number of levels* (see example of col. 15 lines 35-39, “one version of an advertisement can be directed to selling fruit juice to children. Other versions of the advertisement, can be directed to selling the same fruit juice to teenagers, adults, or different demographic groups”. Here, the information has been changed appropriately.).

#### **Regarding claim 12**

Angles further teaches

*wherein said generation means includes input means for receiving a request from said user* (see col. 8 lines 47-49, “the consumer computer executes the advertisement request 26 and established communications link with the advertisement provider computer 18”), and

*a condition designated in accordance with said request is employed as said condition determined in advance* (see col. 14 lines 19-24, “The demographic data can contain a wide variety of information, including, but not limited to, age, sex, income, career, interests, hobbies, consumer preferences, the account number of the consumer’s Internet provider, other account information, etc.” Similar to the rejection of claim 4 above, the condition is defined in advance by the user. Furthermore, a condition for reducing or increasing the amount of information to be

Art Unit: 2121

provide to the consumer are inherently according to the level of detail given by the consumer during registration.).

**Regarding claim 13**

Angles further teaches *wherein said output means selects an intermediate content at a level that corresponds to said condition designated in accordance with said request from said user* (see col. 8 lines 47-49, “the consumer computer executes the advertisement request 26 and established communications link with the advertisement provider computer 18”, and col. 8 lines 58-61, “The advertisement provider computer 18 selects an appropriate advertisement based on the consumer’s profile and then sends the customized advertisement 30 to the consumer computer 12”).

**Regarding claim 14**

Angles further teaches *wherein said generation means generates said intermediate contents by defining, as said condition determined in advance, a reduction or an increase in the amount of information contained by said content* (see col. 14 lines 19-22, “The demographic data can contain a wide variety of information, including, but not limited to, age, sex, income, career, interests, hobbies, consumer preferences”. The advertisement provider uses the demographic data as a condition for providing customized advertise information that defined in advance by the consumer. Furthermore, a condition for reducing or increasing the amount of information to be provide to the consumer are inherently according to the level of detail given by the consumer during registration.).

**Regarding claim 15**

Angles further teaches *wherein said generation means generates said intermediate contents by*

Art Unit: 2121

*defining, as said condition determined in advance, extraction of an information type that represents said content* (see col. 14 lines 19-24, “The demographic data can contain a wide variety of information, including, but not limited to, age, sex, income, career, interests, hobbies, consumer preferences, the account number of the consumer’s Internet provider, other account information, etc.” Similar to the rejection of claim 4 above, the condition is defined in advance by the user. Furthermore, the type of information is provided changes based on the information provided by the consumer during registration.).

**Regarding claim 16**

Angles further teaches *price storage means for storing said content in correlation of with price information; and compensation means for providing compensation information that is based on said price information for each of said intermediate contents at said levels that are generated* (see col. 16 lines 31-34, “the invention can pay an Internet provider 34 based on the number of advertisements viewed by its consumers. The Internet providers 34 can then use this advertising revenue to **reduce consumer access fees**”. The consumer is compensated for looking at the advertisement based on how much Internet provider gets paid from the advertisers.).

Art Unit: 2121

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (703) 305-7587 or the new number (571) 272-3689 beginning Oct. 13<sup>th</sup>, 2004, Monday - Friday from 8:00 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony Knight* at (703) 308-3179 (or (571) 272-3687 starting Oct. 13<sup>th</sup>, 2004).

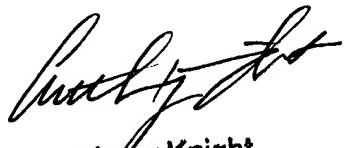
Any response to this office action should be mailed to: **Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450**. Responses may also be faxed to the **official fax number (703) 872- 9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Thomas Pham**  
*Patent Examiner*

*TP*

October 7, 2004

  
**Anthony Knight**  
**Supervisory Patent Examiner**  
**Group 3600**